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REEXAM UNIT

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(For Requester)

In re Campana, Jr. et al.
Request for *Inter Partes* Reexamination Proceeding
For: U.S. Patent No. 5,436,960
Deposited¹: April 17, 2003

:
: **SUPPLEMENTAL**
: **DECISION**
: **DENYING**
: **PETITION**

This is a supplemental decision to the decision mailed on June 6, 2003, on the third party requester's petition of May 6, 2003.¹ The June 6, 2003, decision denied the third party requester petition under 37 C.F.R. § 1.181 for (I) withdrawal of the notice of April 22, 2003,² as improper

¹ The request papers are stated as having been "deposited," as opposed to "filed," since no filing date has been assigned to the papers.

² The April 22, 2003, notice informed requester that the present patent for which *inter partes* reexamination was requested was not eligible for *inter partes* reexamination pursuant to Section 4608 of the American Inventor's Protection Act.

since jurisdiction is proper, (2) waiver of 37 C.F.R. § 1.535(g) and § 1.560 to thus permit requester to participate in a reexamination under 35 U.S.C. 301-307, (3) an order of a Director Initiated Reexamination under 35 U.S.C. 313, and (4) deferral of the effective date for an election required by the Notice of April 22, 2003. This matter is before the Director of the Office of Patent Legal Administration for clarification.

For the reasons set forth in the decision of June 6, 2003, the petition was denied. In addition, the decision stated that the "request papers" and the reexamination filing fee submitted with the request papers were returned to the requester. This supplemental decision clarifies what was returned as the "request papers."

REVIEW OF FACTS

1. U.S. Patent No. 5,436,960 (hereinafter, the '960 patent), issued to Campana, Jr. et al., on July 25, 1995, from an application filed on May 20, 1991.

On April 17, 2003, a request for *inter partes* reexamination was deposited in the Office by the third party requester. The deposited request comprised "request papers" which include a statement that reexamination is requested, a table of contents (of the prior art references), a reference to the filing fee, and a copy of the '960 patent. In addition, the request included two boxes containing the copies of the references cited in the request, as well as claim charts interspersed therewith.

A notice was mailed on April 22, 2003, informing requester that the present patent for which *inter partes* reexamination was requested is not eligible for *inter partes* reexamination (pursuant to Section 4608 of the American Inventor's Protection Act). The notice set a two week period for requester to elect to replace the *inter partes* request for reexamination with an *ex parte* request for reexamination under 37 C.F.R. § 1.510, pointing out that if such an election was not received within the two week period, the request papers would be returned to requester.

4. On May 6, 2003, requester filed a petition requesting (1) withdrawal of the notice as improper, (2) waiver of 37 C.F.R. § 1.535(g) and § 1.560 to permit requester participation in a reexamination under 35 U.S.C. 301-307, (3) a Director Initiated Reexamination under 35 U.S.C. 313, and (4) deferral of the effective date for an election required by the notice.
5. A decision denying the petition was mailed on June 6, 2003³.

³ The address portion of the decision of June 6, 2003, inadvertently indicated that the enclosures sent to requester were request papers deposited December 26, 2002. The body of the decision, however, correctly states in the Conclusion on page 10 that the request papers being returned to requester were deposited on April 17, 2003.

CLARIFICATION RE: RETURN OF PAPERS

The Notice to requester mailed on April 22, 2003, stated in its' last paragraph:

"The *inter partes* reexamination 'request' papers are being temporarily held in the CRU pending a decision as to whether or not requester wants to replace the *inter partes* request for reexamination with an *ex parte* request for reexamination under 37 C.F.R. § 1.510. **If such decision is NOT received within two (2) weeks from the mailing date of this letter, the request papers will be returned to the requester.**"

The petition of May 6, 2003, was filed within the two week period, however, an election was not made in the petition. In addition, the requested deferral of the effective date for an election required by the Notice of April 22, 2003, was not granted. Accordingly, the reexamination request was returned with the decision mailed June 6, 2003.

This supplemental decision clarifies that only the "request papers" were in fact returned with the June 6, 2003, decision; the boxes containing *inter alia* the references were not returned. The request papers which were returned include a statement that reexamination is requested, a table of contents (of the prior art references), a reference made as to the filing fee, and a copy of the '960 patent. The two boxes containing the copies of references cited in the request, as well as the claim chart interspersed therewith, were **not** returned **due to their voluminous nature**.

The boxes of reference copies which accompanied the request for *inter partes* reexamination are being temporarily held in the Central Reexamination Unit (CRU). If the third party requester desires a return of the boxes, then requester should promptly make arrangements to pick up such boxes from the CRU **within one month** of the mailing date of this supplemental decision. Requester should immediately notify Marsha Twitty of the CRU, at telephone number (703) 308-9692, of any arrangements that have been made to pick up such boxes. If the boxes are **not** picked up **within one month** of the mailing date of this supplemental decision, **the CRU may dispose of such boxes**.

The petition, the previous petition decision and the present supplemental decision denying the petition will be made of record in the patent file.

THIRD PARTY REQUESTER'S RECOURSE

As indicated in the previous petition decision, in the event that the third party requester desires to initiate an *ex parte* reexamination of the instant patent, requester may wish to consider filing a new request for *ex parte* reexamination pursuant to 37 C.F.R. § 1.510.

In this regard, note that the **mailing address** for the U.S. Patent & Trademark Office has **changed, as of May 1, 2003**.

All new **requests for an *ex parte* reexamination proceeding** should be directed:

by Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

All correspondence relating to an *inter partes* reexamination proceeding (a new request may not be submitted by FAX) should be directed:

by Mail to: Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

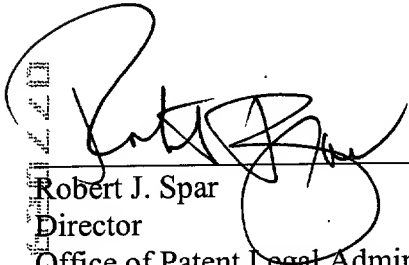
by FAX to: (703) 305-1013
Central Reexamination Unit

By hand: Central Reexamination Unit
Crystal Plaza Three-Four, 3D68
2201 South Clark Place
Arlington, VA 22202

CONCLUSION

1. The third party requester petition filed May 6, 2003, pursuant to 37 C.F.R. § 1.181, was denied in a decision mailed on June 6, 2003, and the present decision is supplemental to that decision.
2. The request for *inter partes* reexamination deposited April 17, 2003, was returned to the requester with the petition decision of June 6, 2003. The return of the request included a refund of the \$8,800 reexamination filing fee by return of the check that was submitted with the request and marked void.
3. The boxes of reference copies (including the claim chart interspersed with the reference copies) were not returned with the decision mailed on June 6, 2003, and the boxes are being temporarily stored in the CRU.

4. If the third party requester desires a return of the boxes, then requester should promptly make arrangements to pick up such boxes from the CRU **within one month** of the mailing date of this supplemental decision.
5. If the boxes are **not** picked up **within one month** of the mailing date of this supplemental decision, then the CRU **may dispose of such boxes**.
6. This decision will be made of record in the patent file, to accompany the petition and the June 6, 2003, decision.
7. Telephone inquiries with regard to this decision should be directed to Lynn M. Kryza, Patent Special Projects Advisor, at (703) 308-0255 or Kenneth Schor, Senior Legal Advisor, at (703) 308-6710. Telephone inquiries with regard to making arrangements for picking up the boxes of references presently stored in the CRU should be directed to Marsha Twitty at (703) 308-9692.

 6/12/03
Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy